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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,053	07/23/2001	Pradeep K. Bansal	1999-0215	3729

7590

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EXAMINER
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ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/911,053

Applicant(s)

BANSAL ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

This Prosecution History is presented to clarify the record.

On 23 July 2001, applicant filed the instant application. There are no claims to priority.

On 10 September 2001, applicant filed a preliminary amendment, amending claims 23 and 46.

On 27 September 2004, the Examiner issued an Election Requirement.

On 24 November 2004, applicant elected Invention I, claims 1-16.

On 7 March 2005, the Examiner issued a non-final rejection of claims 1-16 as anticipated by Li.

On 20 June 2005, applicant filed a response to the Office Action.

The present Office Action is a response to the amendment.

### ***Response to Amendment***

On 20 June 2005, applicant amended claims 1-16.

Claims 1-49 are pending, of which claims 17-49 are withdrawn from consideration as a result of the Election/Restriction Requirement.

### ***Response to Arguments***

Applicant refers to a Final Office Action mailed 15 June 2004. This appears to be an error. Only a non-final rejection has been mailed, on 8 March 2005.

Objections to the Drawings are withdrawn in view of amendment.

Objections to the Claims are withdrawn in view of amendment.

Rejections under 35 USC 101 are withdrawn in view of amendment.

In response to applicant's comments concerning the present invention, page 23, lines 9-17, it is noted that the features upon which applicant relies (i.e., physical address, pointer, shipper of goods, ordering goods or products or widgets) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Concerning features of amended claim 1, page 23, line 18-page 24, line 8, please see rejection.

Applicant argues that the reference does not specifically disclose

- ... an online shipping address directory, a shipping address entry, a shipping address owner or a shipping address, all as required by amended claim 1.
- ...beginning and ending dates may be changed by the address owner to reflect the owner's address on a specific date.
- ...address be changed by the address owner.
- ... claim 2 requires a query that returns an answer providing the address.
- ... claim 2 provide a mechanism for a shipper to securely determine a shipping address for an address owner when the shipper is ready to ship.

In response to these arguments, the Examiner notes that claims 1-16 are directed to a system (i.e., an apparatus) and that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, prior art teaches all the structural limitations of the claim, See MPEP 2114.

When considering each claim as a whole, the Examiner finds that the claims are directed to an apparatus comprising (a) a **server** (which applicant labels a “shipping address directory system server”), (b) media containing data (which applicant labels “online shipping address directory”), in (c) a data structure (a “shipping address entry”) that contains 4 fields (which applicant labels “name of a shipping address owner, etc.) and (d) instructions executable by the server. The claim language contains statements of intended use. The Examiner also finds that the language is static, brings no structural distinction and carries very little patentable weight.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (US 20020178364 A1).

***As per claims 1-16***, Weiss discloses a system for entering shipping address data by an a *shipping* address owner and for providing real-time shipping address information, the system comprising:

(a) a shipping address directory system **server** [Fig. 1, paragraph 38]

(b) computer-readable storage media [Fig. 1, CPU, USR software] accessible to the **server** and containing an online shipping address **directory** [paragraph 29, USR database, Fig. 1, registry] composed of at least one shipping address entry [Fig. 3, address information 38, used for shipping goods to, as in Fig. 10, item 1016].

(c) Each entry data structure may contain multiple fields, as in Fig. 3, which shows a data structure comprising at least 8 areas, including:

- a name of an a shipping address owner [Fig. 1, Person 1, person's name, paragraph 15];
- an a shipping address for said shipping address owner; a beginning date for said *shipping* address [Fig. 3, Person 1, address information

(d) executable instructions for performing various actions. See USR software.

**As per claim 1**, Weiss **does not** specifically disclose a data structure to contain an ending date for said shipping address. Weiss does not specifically disclose that the computer-readable storage media contains instructions executable by the **server** whereby said shipping address and said beginning date and said ending date for said shipping address may be changed by the shipping address owner to reflect the shipping address for said shipping address owner on a specific date.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include any additional type of information since the descriptive material does not interact with media in any sense essential to establish patentability.

**Claims 2-16** are rejected under the same reasoning as claim 1. Weiss discloses structures that are reasonably capable of performing the intended uses recited in claims 2-16.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*James Zurita*  
**Patent Examiner**  
**Art Unit 3625**  
15 November 2005

  
**JOHN W. COGGINS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**